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IN THE

Supreme Court of the United States

October Term, 1963
No. 903

OREGON SAW CHAIN CORP., a corporation,
Petitioner,

vs.

McCULLOCH MOTORS CORPORATION, a corporation,
Respondent.

Petition of Oregon Saw Chain Corp. for Writ of Certiorari to the Court of Appeals for the Ninth Circuit and Brief in Support Thereof.

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Petition of Oregon Saw Chain Corp. for Writ of Certiorari to the Court of Appeals for the Ninth Circuit and Brief in Support Thereof.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, Oregon Saw Chain Corp., respectfully prays that a writ of certiorari issue to the Court of Appeals for the Ninth Circuit to review a judgment of that Court entered on December 23, 1963.

The opinion of the Court of Appeals for the Ninth Circuit was filed October 9, 1963, and a petition for rehearing which was duly filed was denied by that Court on December 13, 1963.

A certified transcript of the record, including the proceedings in the Court of Appeals, is furnished herewith, pursuant to Rule 38 of the rules of this Court.

Summary and Short Statement of the Matter Involved.

Petitioner, Oregon Saw Chain Corp., a corporation, brought this action against McCulloch Motors Corporation, a corporation, for infringement, among others, of letters patent No. 2,622,636 granted December 23, 1952 upon the application of Joseph B. Cox. McCulloch Motors Corporation, by way of motion for summary judgment, asserted that the structures involved did not infringe the patent. The motion for summary judgment was granted by the District Court on the ground of "file wrapper estoppel." Your Petitioner appealed to the Court of Appeals for the Ninth Circuit, which Court affirmed the holding of the District Court on the premise of file wrapper estoppel.

The basic issues involved are:

(1) Can file wrapper estoppel be read into the proceedings before the Patent Office to limit the claims granted in a patent where it is positively shown that the intent of both the applicant and the Patent Office was to give to the claims a broad and comprehensive interpretation free from such "estoppel" limitation?

(2) Can summary judgment be granted to limit the claims of a patent where the facts upon which the premise is predicated of "estoppel" are in dispute between the parties?

ARGUMENT.

The Cox patent is directed to a chain saw and the claims thereof charged to be infringed are Claims 1 through 10 of said letters patent, which are exemplified by Claims 4 and 10 thereof, here reproduced in the appendix hereto. The Cox patent is primary in character and has received extensive recognition. While the application of the Cox patent was pending in the United States Patent Office, there were declared two interferences with the applications co-pending in the Patent Office of Ackley and Merz, Interference Nos. 85,673 and 85,674. The restriction placed by the lower court upon the claims by the doctrine of "estoppel" is to restrict the claims of the Cox patent to a form of chain saw in which the cutting teeth of the chain saw are L-shaped and *have bottom and side cutting portions which are joined at a sharp corner and are not at such corner rounded, curved or arcuate.* Such limitations were imported into and read into the claims of the Cox patent contrary to the clearly expressed intent of the applicant Cox and of the Patent Office in declaring the aforementioned interferences. Such intent of the applicant is shown clearly in the file wrapper where, in the amendment of October 31, 1951, the applicant Cox stated:

> "Obviously, the toe portion may be arcuately curved but the salient feature is that the toe portion extends inwardly from the side wall cutting portion of the cutter element by an amount at least equal to one-half the width of the kerf." [Tr. V-6, 891.]

The intent that the claims of the Cox patent be of a scope to include such curved or arcuate toe portions is

also evident from the act of the Commissioner of Patents in declaring the aforementioned interferences, particularly with the application co-pending of Merz. The Merz application[1] shows only a cutter which is curved, round and arcuate and does not show or disclose a form of chain saw in which the cutting teeth are L-shaped and have bottom and side wall cutting portions which are joined at a sharp corner. In the declaration of the interferences as above noted, the Commissioner of Patents, acting pursuant to the provisions of rules of the Patent Office, declared such interferences after he had determined that the applications disclosed common patentable subject matter. Rule 201 of the Rules of the United States Patent Office requires:

> "201. Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent."

The Cox patent No. 2,622,636 was granted for a chain saw, the new and vital characteristic of which was that it had identical teeth, except for right and left hand configuration, and which teeth combined the side kerf and bottom kerf cutting operations in a single tooth and the bottom cutting portions of the right and left hand teeth extended at least to (Claims 3, 5, 6 and 10)

---

[1]Page of drawings of Merz Patent No. 2,632,484 which was the application of Merz in Interference, appended hereto.

and preferably beyond (Claims 1, 2, 4 and 9) the median line of the kerf formed.

The Cox patent was basic to the art and accounted for the great efficiency of the present day chain saw as a medium for cutting of logs, trees, etc., and for the elimination in the logging industry of the back-breaking kind of manual sawing operations. It was this invention that put the mechanically operated saw chain in business. Before the Cox invention, the saw chain was floundering and had no real success. The art recognized this fact. [Agreement Exhibits, R. 988-1034.]

The Court of Appeals, as does the District Court, recognized the fact that the claims of the Cox patent are not in fact limited to any particular form of cutter teeth.

> "We agree with appellant that at no time does the '636 patent, *by the language of its claims*, urge that the formation of the cutter teeth is in any way 'critical' as to the invention claimed." (Opinion, Ninth Circuit, p. 10.)

Where, then, does the Court find justification for reading into the claims, and each of them, the limitation of a cutter having side and bottom cutting portions joined at a sharp cutting corner. (a) Clearly this is not from the Patent Office proceeding, and (b) therefore must be found in the court's references drawn from disputed facts inferred from the so-called admissions.

In this action it will be obvious that the facts formulating the basis of the decision of the Court of Appeals in this case are in dispute and that under such circumstances, the granting of summary judgment has

deprived your petitioner of its day in court without having the opportunity to be heard fully in the premise.

The decision of the Court of Appeals of the Ninth Circuit, affirming the District Court, on the basis of file wrapper estoppel is clearly in conflict with the decision of this Court in *Hildreth v. Mastoras*, 257 U. S. 27, at 28, 32, 34 and 36. The doctrine of file wrapper estoppel there established is that where there is primary evidence of the construction given a claim by the Patent Office, as by the declaration of interference proceedings, file wrapper estoppel is not applicable to restrict or limit the claims. The interpretation of the claims under such circumstances is to be consistent with that given by the Patent Office:

> "The Patent Office treated the Dickinson invention as a primary or generic one." (257 U. S. 34.)

File wrapper estoppel requires a showing of intent of the Patent Office, acquiesced in by the applicant, that the claims of the patent be specifically limited, as in all rulings of "estoppel" there must be "intent" or failure to act from which intent may be inferred.

Cutter Laboratories v. Lyophile-Cryochem Corp., 179 F. 2d 80, at 87 (Cir. 9, 1949);

Texas Co. v. Anderson-Prichard Refining Corp., 122 F. 2d 829 (Cir. 10, 1941);

Keystone Driller Co. v. Northwest Engineering Corporation, 294 U. S. 42, at 48;

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Thabet Mfg. Co. v. Kool Vent Metal Awning Corp., 226 F. 2d 207 (Cir. 6, 1955);

D & H Electric Company v. M. Stephens, 233 F. 2d 879 (Cir. 9, 1956).

Here the Court of Appeals has endeavored to limit the effect of its holding by stating:

> "Further, the court below, in deciding what the claims were, was passing not only on the file wrapper estoppel, but what the file wrapper showed in the light of the admissions made in this litigation, and by the claims of Cox's '784 patent, all as hereinbefore discussed." (Opinion, filed October 9, 1963.)

The District Court and the Court of Appeals in both their decisions relied upon matters of fact, in controversy, and where evidence could not be produced to enable a proper determination of such facts. Obviously the said admissions are subject to different interpretations.

This Court has said that summary judgment does not lie where there are substantial issues, the facts of which are in controversy, or the purported facts are subject to different inferences.

> *Sartor v. Arkansas Nat. Gas Corp.*, 321 U. S. 620 (1944) and *United States v. Diebold Incorporated*, 369 U. S. 654 (1962).

The rule of the *Sartor* case, *supra*, is that under F. R. C. P. 56, summary judgment lies *only* where it is clear what the truth is and that no genuine issue remains for trial.

The rule of the *Diebold* case, *supra*, is that where inferences contrary to those shown by the trial court are possible, a genuine issue as to ultimate fact exists and that a decision on a motion for summary judgment is in error.

A choice of inferences is not only possible in this case, but is inescapable. The District Court and the Appellate Court both had to ignore the positive intent of the applicant Cox and the Commissioner of Patents to read into the claims the limitations found to exist, and to support their decisions upon the basis of so-called admissions which are not relevant, but are also subject to many inferences other than the ones adopted by the said courts. The result of this action by the District Court and the Appellate Court is obvious; it has deprived your petitioner of its "day in court" contrary to our Constitutional guarantees.

The so-called admissions do not deal with the element of file wrapper estoppel, but are used by the Court to justify its reading into the claims limitations not present. These admissions, if they be such, are taken from partial answers to interrogatories or admissions relative to a patent not here in issue and are relied upon to justify the importation into the claims of limitations, contrary to the express intent of the applicant Cox and which intent was accepted by the Commissioner in the declaration of the said Patent Office interferences. Obviously, many inferences may be drawn from such so-called admissions, and only the presentation of full evidence can determine the correct facts. Under such circumstances, summary judgment is improper.

A situation quite analogous to the *Diebold* case is presented here. The lower courts in Diebold sought to apply the rule of *International Shoe Co. v. Federal Trade Commission*, 280 U. S. 291, to facts susceptible to a choice of inferences. In the instant case, the rule of file wrapper estoppel, *Shepard v. Carrigan*, *supra*, *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S.

126, was applied to a situation where the facts of infringement were in controversy. That a choice of inferences was possible is quite obvious, since there was an express finding of ambiguity in the patent claims by the Court of Appeals. Clearly this is a situation calling for a ruling by this Court.

It is also important for the Court to review the summary judgment procedure followed in the Southern District of California for inconsistency with Rules 52 and 56 of the Federal Rules of Civil Procedure. Rule 56 provides for summary judgment in situations where there is "no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Rule 52(a) specifically provides that findings of fact are unnecessary on decisions of motions under Rule 56. Yet local Rule 3(d)(2) of the United States District Court for the Southern District of California requires proposed findings of fact to be served and filed with each motion for summary judgment. This is an apparent inconsistency, and where as here the findings are in dispute, a situation is engendered contrary to the Federal Rules.

The above procedure has created a conflict in summary judgment procedure between the Southern District of California in the Ninth Circuit on the one hand, and all other circuits on the other. The awkwardness of the situation has even been recognized by the Ninth Circuit Court of Appeals in *Trowler v. Phillips*, 260 F. 2d 924 (1958).

In the *Trowler* case, findings of fact and conclusions of law were prepared and signed. The Court reversed the District Court's grant of the motion for summary judgment stating that unnecessary findings are very

often a telltale flag that point the way to the conclusion that summary judgment should not have been granted. The Court had to concede, however, that it was mindful of the District Court's requirements for findings in local Rule 3(d)(2), although it took no action with respect thereto.

The views of the other circuits on this question are as stated by the Seventh Circuit Court of Appeals in *A R Inc. v. Electro-Voice, Inc.*, 311 F. 2d 508 (1962). That decision clearly holds that specific findings of fact are not required in motions for summary judgment. The Seventh Circuit Court goes even further when it states that where no genuine material factual issue is presented, a court is ill advised to make such findings. A procedural conflict is thus squarely presented. Settlement of the question by this Court will be in the best interests of litigants everywhere and will serve further to clarify summary judgment procedure under the Federal Rules.

The decision of the court below in affirming the grant of the motion for summary judgment on the basis of file wrapper estoppel was clearly erroneous as a matter of law. The facts of infringement were involved and complicated. Proper and correct interpretation of the file wrapper would of necessity have required expert testimony to clarify the state of the saw chain art prior to the invention of the patent in issue, thereby to aid the District Court in understanding the true nature of the advance that had been made. The claims would then have been fully understandable to the District Court and a proper adjudication possib

Such an opportunity, however, was denied by the District Court's ruling on the motion for summary judgment. Instead of having the benefit of expert testimony, the District Court had to rely on argumen propounded by counsel. For example, a critical fact on the issue of infringement relied upon by the courts below [R. 388, 389] relates to an alleged difference between respondent McCulloch's saw chain tooth and the tooth shown in the patent. A specific finding of fact was made that McCulloch's cutting tooth consists of three portions and that of the patent, only two. [R. 439.] Yet this finding was not based on any evidence, but only on an excerpt taken out of context from a memorandum submitted by petitioner's attorneys. [R. 288.] A further fact heavily relied upon by the courts below was also taken out of context from objections that were filed by petitioner's attorneys to interrogatories served by respondent. [R. 213.] Of course, neither the excerpt taken from the memorandum nor that taken from the objections was under oath. Such erosion of the basic principles underlying the motion for summary judgment should warrant this Court's grant of certiorari.

Petitioner is raising the identical issue in a case now pending in the First Circuit. *Omark Industries, Inc. v. Sabre Saw Chain, Inc.*, Civil Action No. 64-27-W. United States District Court for the District of Massachusetts.

Conclusion.

It is the conclusion from this record and from the decision of the District Court [R. 388-389] and of the Court of Appeals herein that the ruling of file wrapper estoppel is contrary to this Court's pronouncement of that doctrine. A contrary intent of the applicant Cox and the Patent Office is clearly evident. That intent is not changed by inferences drawn, when many are possible from the so-called admissions. Petitioner has been deprived of its "day in court," and this is clearly shown to be contrary to this Court's ruling and the premise of summary judgment. The evidence is conflicting.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted.

LEWIS E. LYON,
Attorney for Petitioner.

March 9, 1964.

APPENDIX A.

Claims 4 and 10 Cox patent No. 2,622,636 of Dec. 23, 1952.

4. A saw chain comprising a plurality of pivotally connected links, a succession of cutting elements, all of the cutting elements of said saw chain being identical to each other except that the successive elements are of alternating right and left configuration respectively, each of the cutting elements of said saw chain being provided on an individual link, each of said cutting elements including a kerf side wall cutting portion and a kerf bottom cutting edge portion extending continuously and laterally inwardly from said side wall cutting edge portion beyond the median plane of said chain.

APPENDIX B.

10. In a saw chain comprising a plurality of alternating right and left cutter links, spacer links pivotally connecting adjacent cutter links, each and every one of the cutter links of the saw chain including a flat body having an integral depth gauge extending outwardly from the forward end thereof, and a single integral cutter tooth spaced from said depth gauge, said cutter tooth consisting of a side wall portion and an outer flange portion, said portions being elongated in the direction of the chain, said side wall portion extending laterally outwardly throughout its length in the direction of the chain parallel to said body beyond the lateral extremity of the remainder of the saw chain, the lateral extent of said side wall portion decreasing progressively from the forward edge to the rear end thereof, all of the cutter links of the saw chain being identical to each other other than being of right and left configuration, said flange portions of alternate cutter teeth extending in opposite directions across the median plane of said chain, the foremost edges of both the said side wall and flange portions being sharpened whereby each cutter tooth is thus adapted for cutting both a kerf side wall portion and a kerf bottom portion of at least one-half the width of the kerf bottom.

March 24, 1953 M. MERZ 2,632,484

CHAIN SAW

Filed Nov. 1, 1946 3 Sheets-Sheet 1

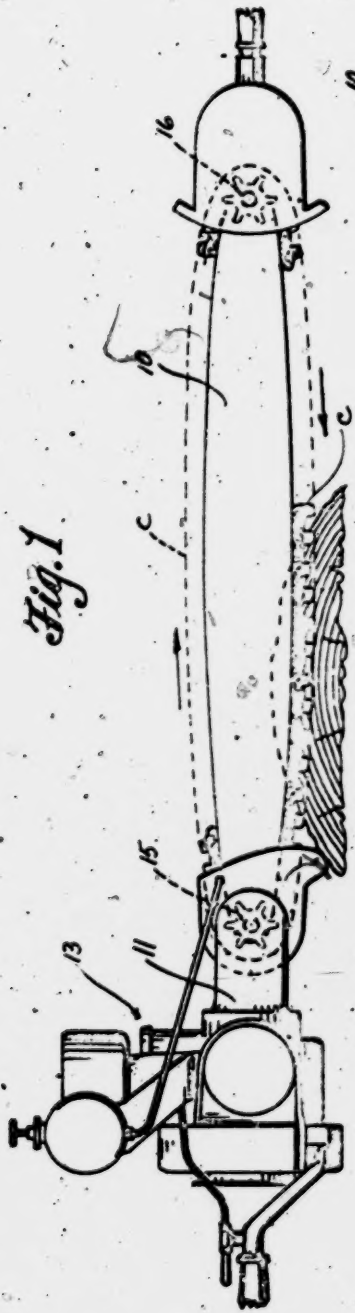

Fig. 1

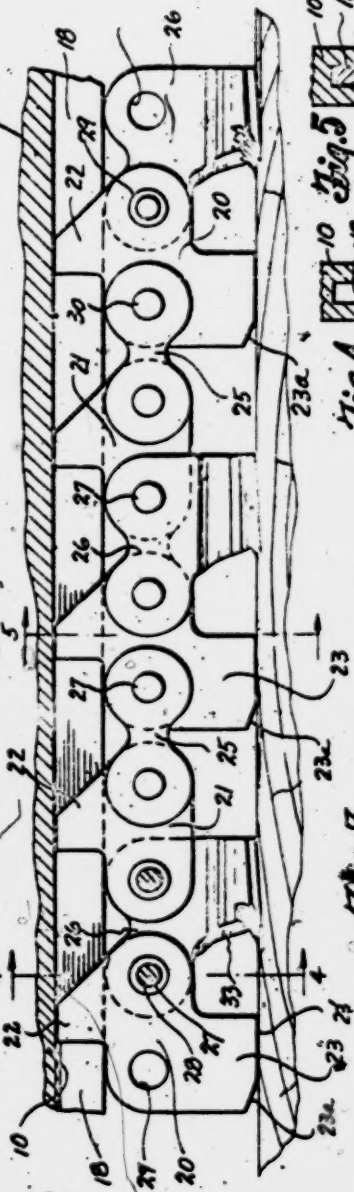

Fig. 2

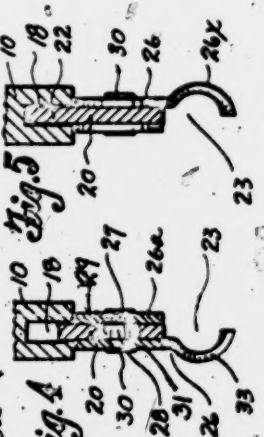

Fig. 5

Fig. 4

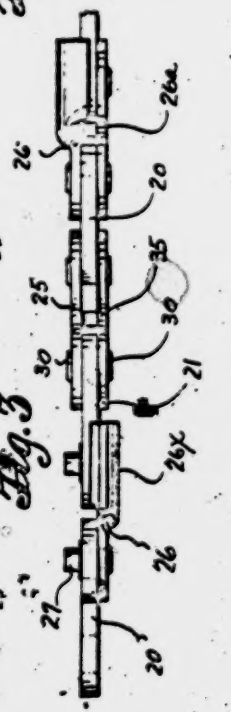

Fig. 3

INVENTOR
MAX MERZ

BY Cook & Robinson
ATTORNEYS

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IN THE

Supreme Court of the United States

October Term, 1963
No. .....

OREGON SAW CHAIN CORP., a corporation,
Petitioner,

vs.

McCULLOCH MOTORS CORPORATION, a corporation,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This case comes before this Court on a Petition by Oregon Saw Chain Corp., defendant below, for a Writ of Certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit.

OPINIONS BELOW.

The citation to the Opinion of the Court of Appeals for the Ninth Circuit is 323 F. 2d 758. The Findings of Fact and Conclusions of Law of the District Court were not reported.

JURISDICTION.

The jurisdiction of this Court is invoked under 28 U. S. C. Section 1254(1).

QUESTIONS PRESENTED.

(1) Can file wrapper estoppel be read into the proceedings before the Patent Office to limit the claims granted in a patent where it is positively shown that the intent of both the applicant and the Patent Office was to give to the claims a broad and comprehensive interpretation free from such "estoppel" limitation?

(2) Can summary judgment be granted to limit the claims of a patent where the facts upon which the premise is predicated of "estoppel" are in dispute between the parties?

STATEMENT OF THE CASE.

This is an ordinary patent case which involves the doctrine of file wrapper estoppel. The doctrine of file wrapper estoppel has been settled by this Court since 1942. See *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, 136-137. Respondent made a Motion for Summary Judgment of non-infringement on the ground that patent No. 2,622,636 can not be construed to cover respondent's structure because of the doctrine of file wrapper estoppel. The District Court granted respondent's Motion for Summary Judgment of non-infringement and denied Petitioner's Motion for Reconsideration. The Court of Appeals affirmed the ruling of the District Court in an Opinion covering 19 pages, and denied petitioner's Petition for Rehearing. No Court of Appeals, other than the Court of Appeals for the Ninth Circuit, has decided the scope of patent No. 2,622,636. Thus, patent No. 2,622,636 is not the subject of an embarrassing conflict of opinion between the Circuit Courts of Appeal.

ARGUMENT.

The Petition for Certiorari should be denied because:

1. This is an ordinary patent case and no conflict of decisions of Courts of Appeal is present.
2. No unusual, unsettled, conflicting or important public interest questions are presented.
3. The decision below is clearly correct.
4. Petitioner has dismally failed to comply with the rules of this Court.

I.

This Is an Ordinary Patent Case and No Conflict of Decisions of Courts of Appeal Is Present.

This is an ordinary patent case with the usual issues of breadth of claims and non-infringement. The Courts below held that because of the proceedings before the Patent Office petitioner was estopped to construe the claims of patent No. 2,622,636 to cover respondent's structures. No District Court* other than the District Court for the Southern District of California, Central Division, and no Court of Appeals, other than the Court of Appeals for the Ninth Circuit, has rendered a decision affecting the breadth of the claims of patent No. 2,622,636. Petitioner, therefore, is not asking this Court to reconcile decisions of two or more Courts of Appeal with respect to patent No. 2,622,636.

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*On page 11 of the Petition, reference is made to the case of Omark Industries *v.* Sabre Saw Chain, Inc., Civil Action No. 64-27-W. This case was filed January 13, 1964. Upon inquiry to the Clerk of the U. S. District Court for the District of Massachusetts on April 6, 1964, respondent learned that defendant on March 12, 1964, filed its Answer and Counterclaim and plaintiff on March 31, 1964, filed its Reply to Counterclaim. This case has not been set for pre-trial or trial.

In *Keller v. Adams-Campbell Co.*, 264 U. S. 314, this Court said (at p. 319):

> "* * * Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent. * * *"

The case of *Layne & Bowler Corporation v. Western Well Works, Inc., et al.*, 261 U. S. 387, was a patent case in which this court originally granted a Writ of Certiorari because it believed that there was a conflict between two Circuit Courts of Appeal, but subsequently dismissed the Writ of Certiorari because it found that the conclusions of the two Circuit Courts were really in harmony and not in conflict. At pages 392 and 393, this Court said:

> "It is manifest from this review of the conclusions in the two circuits as to the validity of the Layne patent and the proper construction to be put upon the 9th, 13th and 20th claims, that they were really in harmony and not in conflict and that there was no ground for our allowing the writ of certiorari to add to an already burdened docket. If it be suggested that as much effort and time as we have given to the consideration of the alleged conflict would have enabled us to dispose of the case before us on the merits, *the answer is that it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of*

the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head." (Emphais added)

II.

No Unusual, Unsettled, Conflicting or Important Public Interest Questions Are Presented.

The doctrine of file wrapper estoppel has been settled by this Court since 1942. See *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126 at pages 136-137, and *Schriber-Scroth Co. v. Cleveland Trust Co.*, 311 U. S. 211, 218, 220-221. The Court of Appeals for the Ninth Circuit in affirming the District Court, applied the doctrine of file wrapper estoppel (see page 768 of 323 F. 2d) in accordance with *Exhibit Supply Co. v. Ace Patents Corp.*, and *Schriber-Scroth Co. v. Cleveland Trust Co.*

In *Magnum Import Co. v. Coty*, 262 U. S. 159, 163 (1923), this Court said:

"* * * The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes, first to secure uniformity of decision between those courts in the nine circuits, *and second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort.* The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing. * * *" (Emphasis added)

III.

The Decision Below Is Clearly Correct.

Petitioner's First "Issue" Is Inaccurate and Insufficient.

The petition sets forth on page 2 only two questions or "basic issues" as a basis for granting a writ of certiorari. These issues are both routine matters of patent law which were fully briefed, considered and ruled upon by the courts below. The mere fact that the petitioner was not satisfied with the unanimous decisions of the lower courts does not constitute a proper or sufficient basis for granting a writ of certiorari.

The "issues" as set forth on page 2 of the petition are clearly "loaded" questions, which incorporate unwarranted and untrue assumptions.

The first "issue" begins: "Can file wrapper estoppel be read into the proceedings before the Patent Office * * *". The opinion of the Court of Appeals clearly shows that estoppel was not "read into the proceedings before the Patent Office." Estoppel was found on the basis of the claims, specification and drawings of the patent in suit, taken together with the Patent Office proceedings and a number of admissions made during the proceedings before the District Court.

In fact, the Court of Appeals held that the claims and specification *alone* clearly showed that the claims cover only L-shaped teeth. In this regard, the opinion states on page 7 [Tr. 1050]:

> "Thus, reading the claims and specifications alone, we can only agree with appellee and the court

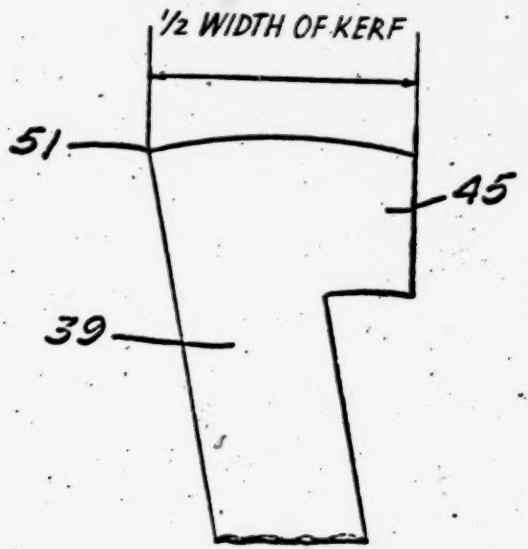
below that the claims cover only cutting edges—joined at an angle, with a sharp cutting corner. This produces an L-shape, without defining the precise angle of the L. L-shaped teeth, and only L-shaped teeth are described in the specifications, and shown in the drawings."

The first "issue" further states "* * * where it is positively shown that the intent of both the applicant and the Patent Office was to give to the claims a broad and comprehensive interpretation * * *" The petition does not indicate where or when such an intent was "positively shown." The record shows that the District Court and the Court of Appeals carefully studied, considered and discussed the Patent Office record and the actions of the petitioner *in extenso* and found that it was positively shown that the claims of the petitioner's patent are limited to L-shaped teeth.

The portions of the petitioner's argument set forth in support of this "issue" are nothing more than a rehash of only a small portion of the issues which were argued before and decided by the Court of Appeals. The petitioner did not make any effort to meet or to discuss all or even most of the grounds set forth in the opinion of the Court of Appeals.

The argument on page 3 of the petition with regard to a curved toe portion was fully briefed and argued before the Court of Appeals. As respondent pointed out in its brief below, when the attorney referred to the *toe portion* as being arcuate, he did not refer to a curved

tooth or to a curved side wall, but to a shape such as shown in the following sketch taken from Respondent's Brief before the Court of Appeals (p. 26):



It should be noted that the remarks stated only that the *toe portion* may be arcuately curved and *not* that the *whole tooth* may be arcuately curved. As illustrated by the above sketch, there is a great deal of difference between a tooth having only the *toe portion* arcuately curved and one in which the *entire tooth* is curved.

The argument on pages 2 and 3 of the petition regarding the declaration of an interference proceeding in the Patent Office between the petitioner and third parties named Merz and Ackley was also fully briefed and argued before the Court of Appeals and ruled upon in its opinion. To avoid repetition, respondent respectfully refers this Court to pages 45-49 of its brief before the Court of Appeals appended hereto and pages 18 and 19 of the opinion of the Court of Appeals. [Tr. 1061-1062].

With regard to the statements made in the first full paragraph on page 5 of the petition, these are gratuitous statements of petitioner's attorneys which have no support or basis in the record.

Petitioner then quotes on page 5 of the petition a *portion* of one paragraph of the 19-page opinion of the Court of Appeals. This portion is taken out of context and its meaning completely twisted. The full context in which the quoted words appeared on page 10 [Tr. 1053] of the opinion was as follows:

"*Fourth Claimed Admission*

"In Supplemental Answer 11 to interrogatories (Tr. p. 125) Oregon stated that the curved tooth of the '784 patent eliminated 'the *critical sharp corner* present in the chain of Patent 2,622,636.'

"Oregon answers this claimed admission by stating the word 'critical' is taken out of context. No so, says McCulloch—

'A sharp corner can be formed only in an L-shaped tooth (sic). If such a sharp corner is critical then the 636 patent must necessarily relate only to L-shaped teeth. It can*not* include curved teeth, which necessarily lack the critical sharp corner.'

"We agree with appellant that at no time does the '636 patent, *by the language of its claims*, urge that the formation of the cutter teeth is in any way 'critical' as to the invention claimed. But this does not solve the problem or eliminate the alleged admission. Its probative value, however, is problematical."

Respondent submits that the foregoing portion of the opinion in no way supports the petitioner's case.

Petitioner's Second "Issue" Is Inaccurate and Insufficient.

Toward the end of page 5 of the petition, the argument shifts, without saying so, to the petitioner's second "issue", which is stated on page 2 of the petition as follows:

> "Can summary judgment be granted to limit the claims of a patent where the facts upon which the premise is predicated of 'estoppel' are in dispute between the parties?"

Once again, the question as worded by the petitioner is "loaded". The question and the petition do not state precisely *what* the facts are in dispute between the parties. The specification, claims and drawings of the patent are a matter of public record and they are certainly not in dispute. The proceedings before the Patent Office are likewise a matter of public record and cannot be in dispute. The physical structure of the respondent's accused saw chains is not in dispute, because the chains themselves and drawings of them were produced before the courts below. The petitioner's own admissions in the proceedings before the District Court could not be in dispute, because they are a matter of record in the District Court.

The truth is that there are no facts which are in dispute between the parties. The only dispute relates to a legal question regarding the interpretation of the claims of the petitioner's patent.

It should be noted that the petitioner did not raise any issues of fact before the District Court. Rule 56(c)

of the Federal Rules of Civil Procedure specifically provides with regard to a motion for summary judgment that: "The adverse party prior to the day of hearing may serve opposing affidavits." The record in this case shows that *no opposing affidavits were ever filed.* The petitioner filed a lengthy brief containing legal arguments, but not a single affidavit on any alleged issue of fact.

Rule 3(d)(2) of the Rules of the United States District Court for the Southern District of California further provides that:

> "Any party opposing the motion may, not later than three days prior to the hearing, serve and file a concise 'statement of genuine issues' setting forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated."

The record shows that the petitioner did *not* file any statement setting forth any material facts whatsoever as to which it contended there existed a genuine issue necessary to be litigated.

Rule 3(d)(2) further provides that:

> "In determining any motion for summary judgment, the court may assume that the facts as claimed by the moving party are admitted to exist without controversy except as and to the extent that such facts are asserted to be actually in good faith controverted in a statement filed in opposition to the motion."

Since the petitioner filed no statement controverting the facts, the District Court was accordingly justified

in assuming that the facts as claimed by the moving party were admitted to exist without controversy.

The briefs and arguments presented by the petitioner in the Court of Appeals likewise related to matters of law rather than fact. For example, the "Concise Argument of the Case" contained on page 4 of petitioner's Opening Brief before the Court of Appeals was as follows, in its entirety:

> "The points of law and fact which will be argued are: (1) The requirements of disclosure in Letters Patent §112 of 35 U.S.C. (2) The disclosure and claims of the Cox Patent. (3) The claims of the Cox patent. (4) The law relevant to patent claims. *Winslow Engineering Co. v. Smith* (CA 9), 223 F.2d 438, 442-443. (5) The file wrapper and its contents of the Cox Patent. (6) The Patent Office construction of claims 1-10 of the Cox Patent as shown by the declaration of Interferences Nos. 85673 and 85674."

It will be noted that no *disputed* facts are listed, nor any contentions regarding the existence of a dispute as to the facts. The "Topical Index" of petitioner's Opening Brief likewise shows no arguments relating to a dispute as to matters of fact.

Page 1 of petitioner's Reply Brief in the Court of Appeals opened with the following statement:

> "The sole issue before this Court is:
>
> "The construction placed upon the claims of the Cox patent No. 2,622,636 by the applicant Cox and the Patent Office at the time of the allowance."

The construction of patent claims is clearly a question of law and petitioner contended that this was the *sole issue* before the Court of Appeals.

On page 15 of petitioner's Reply Brief, petitioner showed that it can not distinguish between issues of fact and law, since it stated:

> "It is obvious from an analysis of this record in the briefs of Appellant and Appellee that the facts are in dispute. File wrapper estoppel is a matter of law. * * *"

Finally, petitioner's Reply Brief concluded on page 16 with the following words:

> "* * * It is thus conclusively shown that the District Court erred *as a matter of law* in so interpreting the claims and that its summary judgment should be reversed." (emphasis added)

The record accordingly shows that the petitioner failed to raise any issues of fact in the courts below. It filed no affidavits whatsoever in opposition to the motion for summary judgment. It filed no "statement of genuine issues" as required by the local rules. It presented no dispute as to matters of fact before the Court of Appeals. Even now, the petitioner can not and does not in its petition point out a single *fact* which is in dispute.

The matters set forth on pages 6 and 7 of the petition are routine questions of patent law which were fully argued before and decided by the Court of Appeals in its careful and well written opinion, which covered 19 pages.

Page 9 of the petition relates to an alleged conflict between Rule 52(a) of the Federal Rules of Civil Pro-

cedure and Rule 3(d)(2) of the Southern District of California. The former rule states that findings of fact are "unnecessary" on motions for summary judgment, while the latter provides for such findings. It should be noted that Rule 52(a) states only that findings of fact are "unnecessary" and not that they are forbidden or prohibited.

The Committee Note of 1946 to Subdivision (a) which accompanied the Amendment of the Rule stated:

> "The last sentence of Rule 52(a) as amended will remove any doubt that findings and conclusions are unnecessary upon decision of a motion, particularly one under Rule 12 or Rule 56, except as provided in amended Rule 41(b)."

In the case of *Trowler v. Phillips*, 260 F. 2d 924, cited by petitioner on page 9 of the petition, the Court of Appeals for the Ninth Circuit said:

> "* * * We have seen findings of fact accompanying summary judgments, Rule 52(a) of the Federal Rules of Civil Procedure, 28 U.S.C.A., which, while unnecessary, did provide a handy summary. * * *" (p. 926)

It may also be noted that in the case of *A. R. Inc. v. Electro-Voice, Incorporated*, 311 F. 2d 508 (CA 7), cited on page 10 of the petition, the Court affirmed the granting of a motion for summary judgment holding a patent invalid even where a conflicting affidavit was filed by the inventor, which the Court regarded as the testimony of an expert witness.

Although the petitioner here complains on page 10 of the petition that it was deprived of presenting expert testimony, yet it produced no affidavit from an expert

when it had an opportunity to do so. In the case of *Thabet Mfg. Co. v. Kool Vent Metal Awning Corp.*, 226 F. 2d 207 (CA 6), cited on page 6 of the petition, the Court said with regard to the interpretation of a word in a disputed patent claim:

> "* * * Extrinsic evidence from an expert witness for the appellee giving a different meaning to the word is, of course, not binding on the Court, and can be disregarded." (citing numerous cases) (p. 210)

IV.

Petitioner Has Dismally Failed to Comply With the Rules of This Court.

Petitioner has failed to comply with Rule 23.1(a). Petitioner has made no reference to the official and unofficial reports of the Opinion of the Court of Appeals for the Ninth Circuit. Petitioner has not appended to its petition the Opinion of the District Court or the Opinion of the Court of Appeals.

Petitioner has failed to comply with Rule 23.1(b). The petition does not contain a concise statement of the grounds on which the jurisdiction of this court is invoked.

Petitioner has failed to comply with Rule 23.1(a)(iii). The petition does not contain the statutory provisions believed (by petitioner) to confer on this Court jurisdiction to review the judgment or decree in question by Writ of Certiorari.

Petitioner has failed to comply with Rule 23.1(h). The petition does not contain a direct and concise argument amplifying the reasons relied on for the allowance of the Writ in accordance with Rule 19.

Respondent believes that petitioner failed to include in its petition a concise statement of the grounds on which the jurisdiction of this Court is invoked, and a direct and concise argument amplifying the reasons relied on for the allowance of the Writ, because:

1. There is no conflict of decisions between two or more Courts of Appeal.
2. The questions presented are not of vital importance. On the contrary, they relate to the well-settled doctrine of file wrapped estoppel.
3. Petitioner, having been defeated in the District Court and Court of Appeals, is merely attempting to have another hearing. In *Magnum Import Co. v. Coty*, 262 U. S. 159, Chief Justice Taft said (at page 163):

   "The jurisdiction (of the Supreme Court to review cases by way of certiorari) was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing. Our experience shows that eighty per cent of those who petition for certiorari do not appreciate these necessary limitations upon our issue of the writ."

4. The resolution of the questions presented by the petition will affect only the particular litigants. In the case of *Rice v. Sioux City Cemetery*, 349 U. S. 70, it was held that:

   "But this Court does not sit to satisfy a scholarly interest in such issues. Nor does it sit for the benefit of the particular litigants. . . .

> 'Special and important reasons' imply a reach to a problem beyond the academic or the episodic.'" In discussing cases where writs of certiorari were improvidently granted and later dismissed, this Court said in a footnote on page 79:
>
> "* * * in a number, it became manifest that the question was of importance merely to the litigants and did not present an issue of immediate public significance."

Rule 23.4 provides that the failure of a petitioner to present with accuracy, brevity and clearness, whatever is essential to a ready and adequate understanding of the points requiring consideration will be a sufficient reason for denying his petition.

In the case of *Fay . Noia*, 372 U. S. 391, 436, this Court held that:

> "The writ of certiorari * * * 'is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor.' Supreme Court Rule 19(1)."

Petitioner has failed to state the grounds on which the jurisdiction of this Court is invoked. Petitioner makes no reference to the factors set forth in Rule 19(1)(b) of this Court. Respondent, from a reading of the petition, is unable to understand the points petitioner is relying upon in support of its petition for certiorari. Respondent believes that there is sufficient

reason for denying the petition. In *Furness, Withy & Company, Limited v. Yang-Tsze Insurance Association, Limited, et al.*, 242 U. S. 430, the Court said (at page 434):

> "* * * Such petitions go first to every member of the court for examination, and are then separately considered in conference. This duty must be promptly discharged. We are not aided by oral arguments and necessarily rely in an especial way upon petitions, replies and supporting briefs. Unless these are carefully prepared, contain *appropriate* references to the record and present with *studied accuracy, brevity and clearness* whatever is essential to ready and adequate understanding of points requiring our attention, the rights of interested parties may be prejudiced and the court will be impeded in its efforts properly to dispose of the causes which constantly crowd its docket."

In *Winston v. Courtney*, this Court denied the petition for failure to comply with Paragraphs 1 and 2 of Rule 38 (essentially the same as present Rule 23), and Paragraph 1 of Rule 12 (essentially the same as Paragraph 1(b) of present Rule 19). The decision denying certiorari appears in part at 322 U. S. 731, as follows:

> "* * * The petition for writ of certiorari to the Supreme Court of Illinois is denied for failure to comply with paragraphs 1 and 2 of Rule 38 and paragraph 1 of Rule 12. * * *"

CONCLUSION.

The Petition for Writ of Certiorari should be denied because there is no conflict of decisions of Courts of Appeal, there is no unusual, unsettled, conflicting or important public interest question presented, the decision below is clearly correct, and petitioner has failed to comply with the rules of this Court.

Respectfully submitted,

R. WELTON WHANN,

Attorney for Respondent.

Los Angeles, California,
April 7, 1964.

APPENDIX.

Brief for Appellee McCulloch Motors Corporation (Respondent) Pages 45-49.

The Declaration of Patent Office Interferences Between Cox and Third Parties Does Not Create Any Estoppel Against Appellee.

Appellant seeks on pages 24-30 of its brief to create some sort of doctrine of file wrapper estoppel *in reverse*. It seeks to use the declaration of certain interference proceedings by the Patent Office as a means of *expanding* the scope of its claims to include the disclosures of other patents. This is contrary to all recognized rules of patent interpretation. In the case of *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274, the Supreme Court held that:

> "* * * As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public." (p. 279).

Since a patentee cannot resort to the specification of his own patent for the purpose of enlarging his claims (*Lanyon v. M. H. Detrick Co.*, 85 F. 2d 875 (C. A. 9)), it should be obvious that a patentee cannot resort to the specification of a patent issued to *someone else* for the purpose of enlarging his claims.

In so far as the interference proceedings in the Patent Office involving the Merz and Ackley patents are concerned, it is pointed out that those proceedings were abortive and never went beyond the preliminary stage. Ackley did not file a preliminary statement and accordingly defaulted. Merz filed a disclaimer, which is another form of default. There was no contest of any kind and nothing was decided.

The action of the Patent Office in declaring the interferences cannot properly be used against McCulloch, the Appellee in this case. McCulloch was not a party to the interferences. The declaration of the interference proceedings was an *ex parte* action involving only the applicants Ackley and Merz. Even Cox was not a party to the action declaring the interferences.

It is a matter of elementary patent law that the declaration of interference proceeding can be set aside and the interference dissolved on a number of grounds, one of which is that a particular party has no right to "make" the claims. Rule 232 of the Rules of Practice of the United States Patent Office provides that:

> "232. *Motions to dissolve.* (a) Motions to dissolve an interference may be brought on the ground * * * (3) *that a particular party has no right to make the claims,* * * *" (emphasis added).

No such motion was ever filed and the issue was never even raised, let alone decided, on an *inter partes* basis. All that happened was that the Patent Office declared interference proceedings between Cox and other applicants in accordance with the provisions of 35 U. S. C. 135, which provides that:

> "Whenever an application is made for a patent which, *in the opinion of the Commissioner*, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be." (emphasis added).

In deciding whether to declare an interference proceeding, the Patent Office never looks beyond the mere words contained in the claims. The Patent Office would not and could not consider matter of file wrapper estoppel arising during the prosecution of the Cox application, since such estoppel is binding only upon Cox. Nor did the Patent Office have before it the admissions made by Oregon in the record before the District Court.

It is well established that an opinion of the Patent Office is not binding upon a Court. In the case of *Stewart-Warner Corp. v. Jiffy Lubrication Co.*, 81 F. 2d 786 (C. A. 8), the Court held that:

> "* * * The rulings indicate an opinion in the Patent Office as to the scope of the Butler patent differing from that reached by the District Court, but the courts are not bound to follow the Patent Office. Dwight & Lloyd Sintering Co. v. Greenawalt (C.C.A. 2) 27 F. (2d) 823, 832." (p. 793).

The case there cited, *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F. 2d 823 is almost directly in point. In that case, the patentee Greenawalt sought to interpret his claims in the light of another patent to Dwight. Even though the claims were originally drawn by Dwight and were copied from the Dwight application, the Court held that they must be interpreted in the light of the Greenawalt specification and disclosure and not that of Dwight.

The claims called for a hood. Greenawalt showed an air tight hood. Dwight did *not* show an air tight hood. The Court nevertheless held that the claims should be

limited to an air tight hood, as shown in the Greenawalt application. The Court held that:

> "* * * The public cannot be charged with notice of a broad interpretation, drawn from matter dehors the specifications, and to put it to an examination of what took place in such an interference as this would be intolerable. No matter what the claims meant when Dwight drew them, in Greenawalt's application they may not be extended beyond their reasonable meaning in that context. But this doctrine need not work conversely; Greenawalt's monopoly may be limited, and the public demesne enla. ,ed, by an interpretation which contracts his claims to less than they might cover, if the specifications stood bare. And so we think they must be." (*Dwight, etc. v. Greenawalt*, 27 F. 2d 823, 832).

The Court also held that if the Patent Office interpretation extended the claims beyond their proper import, they could be restricted, saying:

> "* * * Whatever the meaning the claims had when Dwight used them, once they were authoritatively interpreted upon their allowance, the applicant, who accepted them, took them cum onere. Had that interpretation extended them beyond their proper import when properly construed, it might, indeed, be necessary to restrict them. * * *" (p. 832).

It is accordingly submitted that the matters referred to by Appellant involving the Patent Office interference proceedings could and should not properly be considered

by the Trial Court or this Court in determining the scope of the claims of the Cox patent. The pertinent matters in this regard are the disclosure of the Cox patent and estoppel relating to the interpretation of the claims arising from the disclosure of the patent, its prosecution in the Patent Office and the admissions made on the record by the Appellant in this proceeding before the Trial Court. These are the matters which were considered by the Trial Court and which formed the sound and correct basis for its ruling of non-infringement.